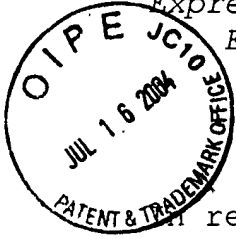


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Docket No.: 2585-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

DPW

re Application of
Jeff WASILKO

Appln. No.: 09/548,308

Filed: April 12, 2000

Group Art Unit: 2143

Conf. No.: 6174

Examiner: A. Boutah

Title: Attenuation, Delay,
Queuing, And Message
Caching Processes For Use
In E-Mail Protocols In
Order To Reduce Network
Server Loading (As Amended)

TRANSMITTAL LETTER

M/S Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Enclosed please find the following:

1. Brief on Appeal (one original and two copies); and
2. Check for fee of \$165.00 (appeal brief fee).

The Director of the U.S. Patent & Trademark Office is hereby authorized to charge any fee deficiency, or credit any overpayment, to Deposit Account No. 18-1579. A duplicate copy of this transmittal letter is enclosed.

Respectfully submitted,

ROBERTS ABOKHAIR & MARDULA, LLC

Kevin L. PONTIUS
Reg. No. 37512
505-922-1400

Date: July 16, 2004

RA&M Ref. No.: 2585-007



Docket No.: 2585-003

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of

Jeff WASILKO

Appln. No.: 09/548,308

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Queuing, And Message
Caching Processes For Use
In E-Mail Protocols In
Order To Reduce Network
Server Loading (As Amended)

**APPELLANT'S BRIEF ON APPEAL
UNDER 37 C.F.R. § 1.192**

M/S Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

In accordance with the provisions of 37 C.F.R. § 1.192,
Appellant submits the following:

I. REAL PARTY IN INTEREST

Based on information supplied by Appellant, and to the best
of Appellant's legal representatives' knowledge, the real party
in interest is the assignee, Service Co., which is a wholly owned
subsidiary of Time Warner Cable.

II. RELATED APPEALS AND INTERFERENCES

An appeal has also been noticed and briefed in related
application no. 09/533,463, which is commonly assigned with the

Date: July 16, 2004

RA&M Ref. No.: 2585-007

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present application.

Appellant, as well as Appellant's assigns and legal representatives are unaware of any other appeals or interferences which will be directly affected by, or which will directly affect, or have a bearing on the Board's decision in the pending appeal.

III. STATUS OF CLAIMS

Claims 1-20 and 23-26 are currently pending. Claims 5, 6, 10-13, 18, and 23-26 have been allowed. Claims 21 and 22 have been canceled. Claims 1-4, 7-9, 14-17, 19, and 20 are appealed.

Claims 1-4, 7-9, 14-17, 19, and 20, as finally rejected, are set forth in the attached Appendix, along with the allowed claims.

IV. STATUS OF AMENDMENTS

No amendment has been filed subsequent to the final rejection.

V. SUMMARY OF THE INVENTION

Appellants' invention as disclosed and recited in the finally rejected claims has two aspects: a method and an apparatus. The method aspect of the invention is recited in finally rejected claims 1-4 and 7-9. The apparatus aspect of the invention is recited in finally rejected claims 14-17, 19, and 20.

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Appellant's invention is generally directed to the idea of making a network operate more efficiently by moderating the tendency of user's email clients from spewing a steady stream of mail requests out across the network to query the user's mail server whether any mail has arrived since the last check. Mail requests are small packets; they do not take up much bandwidth individually. However, when hundreds of thousands of users are using a network at once and their email clients each send out rapid fire mail requests (e.g., once per second), the aggregate affect is to create an unnecessary undertow that reduces the capacity of the network slightly. The amount of capacity lost may not be large, but gone is gone. And, for no good reason, because no user really needs to check for email messages every second they are sitting at their computer.

The present invention (as a method and as an apparatus) moderates the impact on network operations that would occur from unchecked mail requests. A proxy server (so called because it acts as a proxy for a user's true mail server) intercepts the mail requests and lets only a portion of them proceed immediately across the network to the mail server they are intended to find; the others are delayed.

The method aspect of the invention is claimed from the point of view of a proxy server and has two steps. See claim 1. One

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step is to permit a mail request for a mail client to pass through the proxy server to the mail server. See specification at page 18, lines 3-5. The other step is to delay subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied. See specification at page 18, lines 12-15.

Dependent claims 2-4 and 7-9 recite narrower limitations concerning the condition upon which delay is discontinued. See specification at page 18, lines 16-23 and page 19, lines 5-13.

The apparatus aspect of the invention is claimed as a proxy server (refer to block 50 in Fig. 1) that has a processor and a memory and which implements execution of a method having two steps. See claim 14. These steps are the same as claimed in independent method claim 1.

Dependent claims 15-17, 19, and 20 recited narrower limitations concerning the condition upon which attenuation is discontinued. See specification at page 18, lines 16-23 and page 19, lines 5-13.

VI. ISSUES

The two issues on appeal are:

ISSUE 1 - Are claims 1, 2, 4, 7-9, 14, 15, 17, 19, and 20 obvious, within the meaning of 35 U.S.C. § 103, over various

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combinations of Zerber (US 5951636), Batchelor (US 5278984), Miloslavsky (US 5765033), and Wang (US 5956521)?

ISSUE 2 - Are claims 3 and 16 obvious, within the meaning of 35 U.S.C. § 103, over the combination of Zerber (US 5951636) and Toga (US 5987504)?

VII. GROUPING OF CLAIMS

The appealed claims stand or fall according to the following groupings:

Group 1 → Claims 1, 2, 4, 7-9, 14, 15, 17, 19, and 20

Group 2 → Claims 3 and 16

VIII. ARGUMENTS

A. ISSUE 1 - The Obviousness Rejections of Claims 1, 2, 4, 7-9, 14, 15, 17, 19, and 20

Claims 1, 2, 14, and 15 have been rejected under 35 U.S.C. § 103(a) as being obvious over Zerber (US 5951636) in view of Batchelor (US 5278984). Claims 4 and 17 have been rejected under 35 U.S.C. § 103(a) as being obvious over Zerber in view of Batchelor, and further in view of Miloslavsky (US 5765033). Claims 7 and 19 have been rejected under 35 U.S.C. § 103(a) as being obvious over Zerber in view of Batchelor, and further in view of Wang (US 5956521). Claims 8, 9, and 20 have been rejected under 35 U.S.C. § 103(a) as being obvious over Zerber in view of Batchelor and Wang, further in view of Miloslavsky.

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These rejections are addressed collectively in the following arguments.

A.1. The Evidence Does Not Teach What the Examiner Contends

In order to make out a *prima facie* case of obviousness, the prior art must teach or suggest each and every limitation of the claimed invention, as the invention must be considered as a whole. *In re Hirao*, 535 F.2d 67, 190 U.S.P.Q. 15 (C.C.P.A. 1976).

Independent method claim 1 recites the limitation:

 permitting a mail request for a mail client to
 pass through a proxy server to the mail server

at lines 5 and 6. Independent apparatus claim 14 recites a similar limitation at lines 7 and 8.

Independent method claim 1 also recites the limitation:

 delaying subsequent mail requests for the mail
 client at the proxy server until a predetermined
 condition has been satisfied.

See claim 1 at the last two lines. Independent apparatus claim 14 recites a similar limitation at the last three lines.

The obviousness rejections of each of claims 1, 2, 4, 7-9, 14, 15, 17, 19, and 20 each relies upon the Zerber reference as the basic evidence of obviousness. However, as will be explained, Zerber does not well support a case of obviousness because it does not teach what the Examiner contends. Zerber

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does mention the use of a proxy server. Zerber does not suggest the use of a proxy server to selectively pass or delay email requests.

The Examiner notes Figs. 1 and 2 of Zerber as showing this aspect of the invention. See Paper No. 4, at page 3, line 5. However, close review of Zerber shows that machine 6 shown in Fig. 1 cannot be interpreted as a distinct proxy server since Zerber indicates that the "post office system" 4 is implemented ON the machine 6. Likewise, Zerber indicates that the "post office system" 20 of Fig. 2 is implemented ON the server 16.

The Examiner also notes block 52 of Fig. 3 as showing this aspect of the invention. See Paper No. 4, at page 7, line 16. However, close review of Zerber shows that the "local HTTP server" 52 portrayed in Fig. 3 cannot be interpreted as a distinct server since it is simply a functionality of a JAVA applet running on the user's own machine. It is not reasonable to label a little JAVA applet running on the user's own machine as being a proxy server because the functions performed are not those of a server. Rather, the applet functions 52 in Zerber are disclosed as providing an emulation of IMAP4 functionality despite implementation of POP3 protocol. In other words, the applet functionality 52 is simply a plug in to the mail client to

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cause the mail client to behave differently than it otherwise would. The Examiner's contention that the applet functionality 52 performs "the same function in substantially the same way to reach substantially the same result" as that of the claimed invention is not accurate. *Id.* at page 8, lines 1-3. Since the Zerber applet sets up a continuous connection across the network to the mail server, it is agnostic to mail requests. The Zerber scheme provides a constant live update to the user of what is in the mail folders as it exists on the mail server. This is not the same function. It is done in a deliberately very different way.

When Batchelor, Miloslavsky, and/or Wang are further considered along with Zerber, these additional references fail to rectify the shortcomings of the Zerber reference.

The queuing system disclosed by Batchelor does not suggest the claimed invention because it does not provide the proxy server teaching that Zerber lacks.

The intelligent router disclosed by Miloslavsky has nothing relevant to teach concerning selectively permitting or delaying mail requests directed to a mail server from mail clients, and in any case the Examiner does not contend that it does.

The email message delivery system disclosed by Wang works on a system so entirely different from that of POP protocols that it

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cannot reasonably be considered to suggest selectively permitting or delaying email requests directed to a mail server from mail clients, and in any case the Examiner does not contend that it does.

For the above reasons, Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to claims 1, 2, 4, 7-9, 14, 15, 17, 19, and 20.

A.2. The Proposed Modification Would Change The Principle Of Operation Of The Zerber System

If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 U.S.P.Q. 349 (C.C.P.A. 1959).

The Zerber reference teaches emulation of IMAP4 functionality in situations where POP3 protocol has been implemented. It accomplishes this by loading and running a JAVA applet on the user's machine that establishes a link across the network with the mail server. Once Zerber is emulating IMAP4 mail protocol, the concept of a mail request loses its meaning since the user's machine and the mail server are now linked together across the network. That is because "mail request" is a

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construct of the POP3 mail protocol, which is no longer meaningful once the teachings of Zerber are implemented.

To implement delaying of mail requests as taught by Batchelor would first require the person of ordinary skill in the art to subvert the main operating principle of Zerber by negating the emulation of IMAP4 and reintroduce the POP3 concept of a mail request. Because it would change the basic operating principle of the Zerber system, the modification proposed by the Examiner would not have been obvious.

Accordingly, for the above additional reasons, Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to claims 1, 2, 4, 7-9, 14, 15, 17, 19, and 20.

B. ISSUE 2 - The Obviousness Rejections of Claims 3 and 16

In order for a patent claim to be obvious, the prior art must teach or suggest each and every limitation of the claim. That is because the claim must be considered as a whole. *In re Hirao*, 535 F.2d 67, 190 U.S.P.Q. 15 (C.C.P.A. 1976).

Independent method claim 1 recites the limitation:

 permitting a mail request for a mail client to
 pass through a proxy server to the mail server

at lines 5 and 6. Independent apparatus claim 14 recites a similar limitation at lines 7 and 8.

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Independent method claim 1 also recites the limitation:

delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied.

See claim 1 at the last two lines. Independent apparatus claim 14 recites a similar limitation at the last three lines.

When considered together, Zerber and Toga do not teach or suggest either of these expressly recited limitations. Neither mentions the use of a proxy server. Neither suggests the use of a proxy server to selectively pass or delay email requests.

The Examiner notes Figs. 1 and 2 of Zerber as showing this aspect of the invention. See Paper No. 4, at page 3, line 5. However, close review of Zerber shows that machine 6 shown in Fig. 1 cannot be interpreted as a distinct proxy server since Zerber indicates that the "post office system" 4 is implemented ON the machine 6. Likewise, Zerber indicates that the "post office system" 20 of Fig. 2 is implemented ON the server 16.

The Examiner also notes block 52 of Fig. 3 as showing this aspect of the invention. See Paper No. 4, at page 7, line 16. However, close review of Zerber shows that the "local HTTP server" 52 portrayed in Fig. 3 cannot be interpreted as a distinct server since it is simply a functionality of a JAVA applet running on the user's own machine. It is not reasonable

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to label a little JAVA applet running on the user's own machine as being a proxy server because the functions performed are not those of a server. Rather, the applet functions 52 in Zerber are disclosed as providing an emulation of IMAP4 functionality despite implementation of POP3 protocol. In other words, the applet functionality 52 is simply a plug in to the mail client to cause the mail client to behave differently than it otherwise would. The Examiner's contention that the applet functionality 52 performs "the same function in substantially the same way to reach substantially the same result" as that of the claimed invention is not accurate. *Id.* at page 8, lines 1-3. Since the Zerber applet sets up a continuous connection across the network to the mail server, it is agnostic to mail requests. The Zerber scheme provides a constant live update to the user of what is in the mail folders as it exists on the mail server. This is not the same function. It is done in a deliberately very different way.

The system disclosed by Toga delivers requested information using SMTP protocol as an alternative to transmission via an HTTP protocol via which the information was requested. Although this may have the beneficial effect of moderating network load, it has nothing to do with the claimed subject matter of selectively

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permitting or delaying POP checks directed to a mail server from mail clients.

Accordingly, Appellant respectfully submits that the Examiner has not established a *prima facie* case of obviousness with respect to claims 3 and 16.

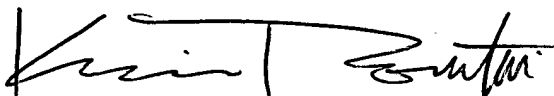
IX. CONCLUSION

For the above reasons, Appellant respectfully submits that the Examiner has failed to make out a *prima facie* case of obviousness with regard to claims 1-4, 7-9, 14-17, 19, and 20, and asks that the obviousness rejections be reversed.

The present Brief on Appeal is being filed in triplicate.

Appellant hereby petitions for any extension of time that may be required to maintain the pendency of this case, and any required fee for such extension is to be charged to Deposit Account No. 18-1579.

Respectfully submitted,
ROBERTS ABOKHAIR & MARDULA, LLC



Kevin L. PONTIUS
Reg. No. 37512
505-922-1400

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APPENDIX

Complete listing of claims, including appealed claims 1-4, 7-9, 14-17, 19, and 20:

1. *(Original)* A method of moderating traffic load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

 permitting a mail request for a mail client to pass through a proxy server to the mail server; and

 delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied.

2. *(Original)* The method of claim 1, wherein the predetermined condition is a predetermined period of time.

3. *(Original)* The method of claim 2, wherein the predetermined period of time is dynamically determined based on the amount of traffic load on the network.

4. *(Original)* The method of claim 2, wherein the predetermined period of time is dynamically determined based on past behavior of the mail client.

5. *(Previously Presented)* A method of moderating traffic

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load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

 permitting a mail request for a mail client to pass through a proxy server to the mail server;

 delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied, wherein the predetermined condition is a predetermined period of time that is dynamically determined based on past behavior of the mail client; and

 transmitting a message to the mail client providing information that the mail client's mail requests will be delayed as a result of the mail client's past behavior.

6. *(Original)* The method of claim 5, wherein transmitting a message comprises providing instructions on how to modify mail client software.

7. *(Original)* The method of claim 1, wherein the predetermined condition is a combination of a predetermined time period and receipt of a notification from the mail server that mail has been received for the mail client at the mail server, whichever occurs first.

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8. *(Original)* The method of claim 7, wherein the predetermined period of time is dynamically determined based on the amount of traffic load on the network.

9. *(Original)* The method of claim 7, wherein the predetermined period of time is dynamically determined based on past behavior of the mail client.

10. *(Previously Presented)* A method of moderating traffic load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

 permitting a mail request for a mail client to pass through a proxy server to the mail server;

 delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied, wherein the predetermined condition is a combination of a predetermined time period and receipt of a notification from the mail server that mail has been received for the mail client at the mail server, whichever occurs first, and wherein the predetermined period of time is dynamically determined based on past behavior of the mail client; and

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transmitting a message to the mail client providing information that the mail client's mail requests will be delayed as a result of the mail client's past behavior.

11. (*Previously Presented*) A method of moderating traffic load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

permitting a mail request for a mail client to pass through a proxy server to the mail server; and

delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied;

wherein delaying subsequent mail requests includes attenuating transmission of the subsequent mail requests.

12. (*Previously Presented*) A method of moderating traffic load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

permitting a mail request for a mail client to pass through a proxy server to the mail server; and

delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied;

wherein delaying subsequent mail requests is suspended in

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the event it is determined that a user is manually initiating rapidly repeated mail requests.

13. (*Previously Presented*) A method of moderating traffic load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

 permitting a mail request for a mail client to pass through a proxy server to the mail server; and

 delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied;

 wherein delaying subsequent mail requests is achieved by inserting multiple delays that are inserted at different points in a mail protocol.

14. (*Original*) A proxy server for use in a network where electronic mail is retained for retrieval from at least one mail server, the proxy server comprising:

 a processor, and

 a memory including software instructions adapted to enable the proxy server to perform the steps of:

 permitting a mail request for a mail client to pass through the proxy server to the mail server; and

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delaying subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied.

15. *(Original)* The proxy server of claim 14, wherein the predetermined condition is a predetermined period of time.

16. *(Original)* The proxy server of claim 15, wherein the predetermined period of time is dynamically determined based on the amount of traffic load on the network.

17. *(Original)* The proxy server of claim 15, wherein the predetermined period of time is dynamically determined based on past behavior of the mail client.

18. *(Previously Presented)* A proxy server for use in a network where electronic mail is retained for retrieval from at least one mail server, the proxy server comprising:

a processor, and

a memory including software instructions adapted to enable the proxy server to perform the steps of:

permitting a mail request for a mail client to pass

through the proxy server to the mail server;

delaying subsequent mail requests for the mail client at

the proxy server until a predetermined condition has

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been satisfied, wherein the predetermined condition is a predetermined period of time that is dynamically determined based on past behavior of the mail client; and

transmitting a message to the mail client providing information that the mail client's mail requests will be delayed as a result of the mail client's past behavior.

19. *(Original)* The proxy server of claim 14, wherein the predetermined condition is a combination of a predetermined time period and receipt of a notification from the mail server that mail has been received for the mail client at the mail server, whichever occurs first.

20. *(Original)* The proxy server of claim 17, wherein the predetermined period of time is dynamically determined based on the amount of traffic load on the network.

21. *(Canceled)*

22. *(Canceled)*

23. *(Previously Presented)* A proxy server for use in a network where electronic mail is retained for retrieval from at least one mail server, the proxy server comprising:

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a processor, and
a memory including software instructions adapted to enable
the proxy server to perform the steps of:

 permitting a mail request for a mail client to pass
 through the proxy server to the mail server; and
 delaying subsequent mail requests for the mail client at
 the proxy server until a predetermined condition has
 been satisfied;

wherein delaying subsequent mail requests is suspended in the
event it is determined that a user is manually initiating rapidly
repeated mail requests.

24. (*Previously Presented*) A proxy server for use in a
network where electronic mail is retained for retrieval from at
least one mail server, the proxy server comprising:

 a processor, and
 a memory including software instructions adapted to enable
the proxy server to perform the steps of:

 permitting a mail request for a mail client to pass
 through the proxy server to the mail server; and
 delaying subsequent mail requests for the mail client at
 the proxy server until a predetermined condition has
 been satisfied;

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wherein delaying subsequent mail requests is achieved by inserting multiple delays that are inserted at different points in a mail protocol.

25. (*Previously Presented*) A proxy server for use in a network where electronic mail is retained for retrieval from at least one mail server, the proxy server comprising:

a processor, and

a memory including software instructions adapted to enable the proxy server to perform the steps of:

permitting a mail request for a mail client to pass

through the proxy server to the mail server; and

delaying subsequent mail requests for the mail client at

the proxy server until a predetermined condition has been satisfied;

wherein delaying subsequent mail requests includes attenuating transmission of the subsequent mail requests.

26. (*Original*) A method of moderating traffic load on network servers in a network where electronic mail is retained for retrieval from at least one mail server, the method comprising:

permitting a mail request for a mail client to pass through a proxy server to the mail server;

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applying remedial handling of subsequent mail requests for the mail client at the proxy server until a predetermined condition has been satisfied, the remedial handling being selected from the group consisting of: delaying and attenuating; and

transmitting a message to the mail client providing information that the mail client's mail requests will be delayed as a result of the mail client's past behavior

wherein the predetermined condition is a predetermined period of time that is dynamically determined based on past behavior of the mail client.